II. Status of Claims

Claims 39-41, 43, 45, 47-50, 54, 56, 57, 68, and 79-110 are present in this application and pending on the merits.

III. Claim Rejections under 35 U.S.C. § 112

The Office has rejected claims 39, 68, and 110 under 35 U.S.C. § 112, first paragraph, alleging that "[w]hile there is support for 'the grinding may be carried out in one or more grinding stages' … there is no support for the 'ending in a final grinding stage.'" Office Action at 3. However, where a grinding process is carried out in one or more stages, it must necessarily have "a final grinding stage." Where there is only one grinding stage, that single stage would be the final stage. Where there is more than one grinding stage, the last stage would be the final stage. This attribute is inherent and necessarily present in Applicant's originally-filed disclosure, and thus, it does not constitute new matter, even though not explicitly recited in the specification. *See* MPEP § 2163.07(a).

The Office also rejected claims 80, 103, 104, and 110 under 35 U.S.C. § 112, first paragraph, alleging that "[w]hile there is support for up to about 50% by weight … , there is no support for ['up to 35%']." Office Action at 3. Applicant respectfully submits that the subject matter recited by that amendment simply claims less than the full scope of the range disclosed in the present application–a legitimate procedure for inventors entitled to decide the bounds of protection they seek. *See* MPEP § 2163.05 (III) (citing *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (C.C.P.A. 1976) (finding that the claimed range "between 35% and 60%" was fully described by the specification's recitation of

"25% - 60%.")). Accordingly, no new matter has been added by these amendments, and Applicant respectfully requests that the rejections under 35 U.S.C. § 112 be withdrawn.

IV. Claim Rejections under 35 U.S.C. § 103(a)

A) The Rejections

For the same reasons explained in the Office Action mailed on April 13, 2009, the Office has rejected the pending claims under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bown, either alone, or in combination with one or more of U.S. Patent No. 6,315,867 to Skuse et al. ("Skuse"), U.S. Pat. App. Pub. No. US 2002/0117085 A1 to Wesley ("Wesley"), Applicant's allegedly "Admitted Prior Art", and U.S. Patent No. 4,915,845 to Leighton et al. ("Leighton"). Office Action at 4-5. For at least the reasons already of record in this application, as well as those below, Applicant respectfully traverses these claim rejections.

B) Bown Does Not Teach Or Suggest "a Sub-Effective Amount of at Least One Dispersant for the Inorganic Particulate Material at Completion of the Final Grinding Stage," as Claimed

The present specification defines "a sub-effective amount" as an "amount . . . not sufficient to give rise to deflocculation of the particulate inorganic material, so that the flocculation characteristics are substantially the same as would be found in the complete absence of any dispersant." Page 3, lines 6-10; *see also* Applicants Request for Reconsideration dated August 11, 2008, at pages 2-4.

In contrast, Bown explicitly teaches that "[i]t is normally required that the final suspension will be fully dispersed, and will not require further additions of a dispersing

agent to render it fluid." Col. 5, lines 46-57. Bown further explains that "[t]he total quantity of dispersing agents used in the method of the invention should be sufficient to provide a fully deflocculated final suspension." Col. 7, lines 63-65. Thus, Bown makes clear that, at completion of the final stage of grinding, the amount of dispersant used must be an effective amount "sufficient to provide a fully deflocculated final suspension."

Skuse, Wesley, Applicant's allegedly Admitted Prior Art, and/or Leighton fail to overcome the above-noted deficiencies of the claim rejection based on Bown. As such, Bown, whether taken alone or in any combination with Skuse, Wesley, Applicant's allegedly Admitted Prior Art, and Leighton, cannot render obvious pending claims 39-41, 43, 45, 47-50, 54, 56, 68, 79, or 110, and Applicant respectfully requests that the rejections be withdrawn.

C) Bown Does Not Teach Or Suggest "the Inorganic Particulate Material at a Solids Level up to About 35% by Weight, Based on the Total Weight of the Suspension," as Claimed

While, the Office asserts that Bown teaches "using at least 20% by weight of particulate inorganic material (col. 2, lines 27-28, and col. 3, lines 13-15), which also overlaps with those claimed" (Office Action at 7), Applicant respectfully submits that the Office has misunderstood the teachings of Bown. In disclosing a process for preparing a concentrated aqueous suspension of finely ground particulate material, Bown appears to define the percentage of the starting material that should begin in coarse particulate form before the step of grinding takes place ("at least 20%"). Col. 2, lines 27-29. This portion of Bown does not appear to teach or suggest the claimed solids level. Notably, Bown teaches that the concentrated aqueous solutions of its invention may have "a higher percentage by weight of particles having an e.s.d. smaller than 2 μm for a given

fluidity, solids concentration and dispersing agent dose." Col. 2, lines 13-16. In making such a claim, the coarseness of the starting material would of course be a factor. In fact, Bown teaches that the starting material may have a particle size distribution such that at least about 30% has an esd less than 10 μm and not less than 20% has an esd less than 2 μm. Col. 3, lines 59-63.

In contrast to the disclosure in column 2, lines 27-29, dealing with the coarseness of the starting material, column 3, lines 13-15, appears to teach the solids level of its aqueous suspension (i.e., teaching that "the concentration of the particulate inorganic material in the suspension in step (a) is preferably at least 40% by weight"). "At least 40%" is of course higher than the "up to about 35%," which is recited in Applicant's claims. While the Examiner indicated during the Interview her understanding that the disclosure in column 3, lines 13-15, was meant to further limit the disclosure of column 2, lines 27-29, Applicant does not believe this to be correct. The language used in column 3, lines 13-15, of Bown is clearly different from the language used in column 2, lines 27-29. While the language in column 2 refers to the % by weight "of the particulate material in coarse particulate form," the language in column 3 refers to the % by weight comprising the "concentration of the particulate inorganic material in the suspension." Thus, the two do not appear to be related to the same aspect of Bown's disclosure.

During the Interview, the Examiner mentioned that Bown also appears to discuss high and low solids grinding in column 4. Notably, this portion of Bown also does not disclose the use of a sub-effective amount of dispersant during grinding of an inorganic particulate material at a solids level up to about 35% by weight, as claimed. In

particular, in discussing a potential preliminary grinding step at low solids (defined as "below 50% by weight"), Bown explicitly teaches that such grinding should be conducted "without a dispersing agent." Col. 4, lines 10-21.

Skuse, Wesley, Applicant's allegedly Admitted Prior Art, and/or Leighton fail to overcome the above-noted deficiencies of the claim rejection based on Bown. As such, Bown, whether taken alone or in any combination with Skuse, Wesley, Applicant's allegedly Admitted Prior Art, and Leighton, cannot render obvious pending claims 80-110, and Applicant respectfully requests that the rejections be withdrawn.

V. Conclusion

For at least the reasons set forth above, Applicant respectfully requests reconsideration of this application, reconsideration and withdrawal of the claim rejections, and allowance of pending claims 39-41, 43, 45, 47-50, 54, 56, 57, 68, and 79-110.

Applicant respectfully submits that the final Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether any of those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6430.

Please grant any extensions of time required to enter this Request for Reconsideration and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: /Jeffrey A. Freeman/
Jeffrey A. Freeman
Reg. No. 58,275